

## **REMARKS**

### **Interview**

Counsel wishes to extend thanks to Examiners Ford and Kunz for the interview of April 19, 1999. The interview was very beneficial in furthering the prosecution of the instant application.

At the interview, counsel proposed filing the present request and first submission for transitional practice under Rule 129. As discussed at the interview, this submission combines nonelected claims of continuation application Serial No. 08/835,964 with nonelected claims already pending in the instant application.

In a telephone message subsequent to the April 19, 1999, interview, Examiner Ford raised a procedural issue concerning the submission under Rule 129. Specifically, Examiner Ford noted that upon entry of the submission the pending claims would all be directed to a combination of at least two active ingredients. Examiner Ford indicated he does not examine such subject matter. Instead, such subject matter would likely be examined in Art Unit 1614.

Counsel telephoned Supervisory Primary Examiner Marianne Cintins, who heads Art Unit 1614, to inquire whether her Art Unit would accept transfer of the application if the submission under Rule 129 was filed. Ms. Cintins advised counsel that she would accept transfer of the application.

### **Amendments**

As mentioned above, the above amendments to the claims are a first submission under 37 C.F.R. §1.129, i.e., transitional practice. The instant application is presently under Final Rejection. Furthermore, the application has been pending more than two years as of June 8, 1995. Also, submitted herewith is the required \$760 fee under 37 C.F.R. §1.17(r). Thus, it is respectfully submitted that the instant application is entitled to have this first submission entered and considered pursuant to Rule 129.

The instant application is co-pending with continuation application Serial No. 08/460,854. Previously, Serial No. '854 contained only composition claims whereas the instant application contained only method claims. The composition claims in the Serial No. '854 were restricted into two groups, the non-elected group being directed to a composition containing the (-)-enantiomer, (-)-*cis*-4-amino-1-(2-hydroxymethyl-1,3-oxathiolan-5-yl)-(1H)-pyrimidin-2-one, and another agent. Analogously, the method claims

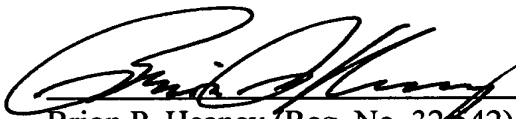
of the instant application were restricted into two groups, the non-elected group being directed to a method involving the use of the (-)-enantiomer, (-)-*cis*-4-amino-1-(2-hydroxymethyl-1,3-oxathiolan-5-yl)-(1H)-pyrimidin-2-one, and another agent.

Applicants now wish to pursue the non-elected claims from both applications in the instant application. Thus, claims corresponding to the non-elected composition claims of Serial No. '854 have been added. Further, by the above amendments, the prior elected claims of this application are either canceled or amended to depend from prior nonelected method claims. As a result, all of the pending claims in the present application are directed to either a composition comprising the (-)-enantiomer, (-)-*cis*-4-amino-1-(2-hydroxymethyl-1,3-oxathiolan-5-yl)-(1H)-pyrimidin-2-one, and another agent having antiviral activity, or a method of treating an HIV infection using such a composition.

As for Serial No. '854, applicants have canceled all pending claims, both elected and non-elected, and submitted new claims for purposes of initiating an interference with U.S. Patent No. 5,746,478, issued May 26, 1998.

Favorable consideration of the above claims is respectfully requested.

Respectfully submitted,



Brion P. Heaney (Reg. No. 32,542)  
Attorney for Applicants

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
Arlington Courthouse Plaza I  
2200 Clarendon Boulevard, Suite 1400  
Arlington, Virginia 22201  
Direct Dial: 703-812-5308  
Facsimile: 703-243-6410  
Internet Address: [heaney@mwzb.com](mailto:heaney@mwzb.com)

**Filed: June 25, 1999**

K:\PAT\IAFG\14\US\Rule 129.wpd